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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFF STEWART and JENNIFER R. PINCO

Appeal 2011-011457
Application 09/709,433
Technology Center 2100

Before LANCE LEONARD BARRY, ST. JOHN COURTENAY III, and
CAROLYN D. THOMAS, *Administrative Patent Judges*.

COURTENAY, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have filed a second Request for Rehearing (hereinafter “Second Request”) under 37 C.F.R. § 41.52(a)(1) for reconsideration of our previous “Decision on Request for Rehearing” of Jan. 13, 2012 (hereinafter “Rehearing Decision”).

The Rehearing Decision granted-in-part, denied-in-part Appellants' request, and affirmed-in-part the Examiner's § 103 rejection of claims 12, 15, 16, 20, 24, 31, 32-34 and 42, over the combination of Adamske in view of Tonkin, as follows:

1. We set forth new grounds of rejection of independent claim 12 and associated dependent claims 13-16, and 32-34, under § 112, second paragraph, as being indefinite. (Rehearing Decision 5).
2. We *pro forma* reversed the Examiner's §103 rejection of independent claim 12, and claims 15, 16, and 32-34, which depend from claim 12.¹ (Rehearing Decision 5).
3. We denied Appellants' request to reverse our original Decision of Nov. 2, 2011, that sustained the Examiner's obviousness rejection of independent claims 20, 24, 31, and 42. (Rehearing Decision 5-6).

In the Second Request (1), Appellants request reconsideration of our Rehearing Decision regarding of the rejections of claims 12, 15, 16, and 32-34 for the following reasons:

1. "The Board's alternative interpretation regarding the scope of the 'an application configured to at least one of' clause is not plausible."
(Second Request 4).

¹ Claims 13 and 14 also depend from independent claim 12 and were reversed in our original Decision of Nov. 2, 2011 at page 12.

2. “The USPTO Goal of Compact Prosecution Requires the Board to Resolve the Core Issue of the Appeal.” (Second Request 6).

For convenience, we reproduce independent claim 12 below:

12. A method of previewing a document over a network, the method comprising:
- providing system software for use on a client, wherein the system software allows a user of the client to use an application configured to at least one of: display or edit the document to request to remotely print the document, and, in response to the request and without user-initiated interaction with a server, generates a print file on the client based on the document, transmits the print file from the client to the server in response to the generation of the print file, and prompts the user to configure and preview a bound copy of the document using a browser in response to the transmission of the print file;
 - obtaining the print file from the system software executing on the client on the server; and
 - providing a configuration wizard for display in a browser on the client in response to a request from the client.

(emphasis added).

In the Second Request, Appellants again contest the Board's construction of the "providing system software" clause of claim 12. Appellants contend that a proper construction requires consideration of *all* of the elements in the list that are recited following the “at least one of” language, in light of *SuperGuide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870 (Fed. Cir. 2004). (Second Request 3, 6).

In *SuperGuide*, the Federal Circuit considered the interpretation of the claim phrase: *at least one of a desired program start time, a desired program end time, a desired program service and a desired program type*. See *Superguide*, 358 F.3d at 885.

As a matter of claim construction, the court held:

The phrase “at least one of” precedes a series of categories of criteria, and the patentee used the term “and” to separate the categories of criteria, which connotes a conjunctive list. A common treatise on grammar teaches that “an article of a preposition applying to all the members of the series must either be used only before the first term or else be repeated before each term.” William Strunk, Jr. & E.B. White, *The Elements of Style* 27 (4th ed. 2000). Thus, “[i]n spring, summer, or winter” means “in spring, in summer, or in winter.” *Id.* Applying this grammatical principle here, the phrase “at least one of” modifies each member of the list, i.e., each category in the list. Therefore, the district court correctly interpreted this phrase as requiring that the user select at least one value for each category; that is, at least one of a desired program start time, a desired program end time, a desired program service, and a desired program type.

SuperGuide, 358 F.3d at 886.

Here, Appellants’ claim 12 is distinguished because it does not have the identical form to the list of categories considered by the Federal Circuit in *Superguide*.

Appellants’ claim 12 recites an “at least one of” clause of the following form:

providing system software for use on a client,²
wherein the system software allows a user of the client to
use an application configured to at least one of:

(A - display) or (B – edit the document to request
to remotely print the document),

and, (C – in response to the request)

and (D – the recited negative limitation of
“without user-initiated interaction with a server”),

(E - generate a print file),

(F - transmit the print file . . . in response to the
generation),

and (G - prompt the user . . . in response to the
transmission of the print file);

We particularly note the use of “or” between aforementioned
limitations A (*display*) and B (*edit the document to request to remotely print
the document*). In contrast, the claims considered by the court in *SuperGuide*
did not recite “or” between any of the listed categories.³

In addition, Appellants’ claim 12 is not directed to *user selection* of at
least one value for each item in a list of categories as was the case in
SuperGuide. (*Id.* 358 F.3d at 886). The steps of claim 12 are recited as being
performed by an *application* that is “configured to” perform the steps.⁴

² See n.4 *infra*.

³ Cf. also several District Court cases that distinguish specific claim
interpretations over *SuperGuide*: e.g., *Joao v. Sleepy Hollow Bank*, 348
F.Supp.2d 120, 124 (S.D.N.Y. 2004) (“in *SuperGuide*, interpreting the
phrase in the grammatically correct fashion made sense in the context of the
patent specifications. Reading the phrase in the same way here would render
the claims utter nonsense.”).

⁴ “An intended use or purpose usually will not limit the scope of the claim
because such statements usually do no more than define a context in which
the invention operates.” *Boehringer Ingelheim Vetmedica, Inc. v. Schering-*

Lastly, the USPTO applies a different standard of claim construction⁵ than the standard of claim construction applied by the Federal Circuit during patent infringement proceedings,⁶ such as *SuperGuide*.

As stated in our Rehearing Decision (4-5), we conclude that Appellants' use of the phrase "at least one of" that precedes the alternative language "or" in claim 12 renders the scope of the claim subject to two plausible interpretations.

Under a first plausible interpretation, if the user elects to "at least one of" (A) *display* the document, then the (B) limitation of *editing the document to request to remotely print the document* is not positively recited as actually occurring. (Claim 12).

In contrast, Appellants contend that regardless of whether the document is displayed (A) or edited (B), all of the limitations C-G must be met by the cited combination of prior art. (First Request 5-6; Second Request 4-5).

Plough Corp., 320 F.3d 1339, 1345 (Fed.Cir. 2003). Although "[s]uch statements often . . . appear in the claim's preamble," *In re Stencel*, 828 F.2d 751, 754 (Fed.Cir. 1987), a statement of intended use or purpose can appear elsewhere in a claim. *Id.*

⁵ "[T]he PTO gives claims their 'broadest reasonable interpretation.'" *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)).

⁶ See *Markman v. Westview Instruments, Inc.* 52 F.3d 967, 979 (Fed. Cir. 1995), *aff'd*, 517 U.S. 370 (1996) ("To ascertain the meaning of claims, we consider three sources: The claims, the specification, and the prosecution history' . . . 'Expert testimony, including evidence of how those skilled in the art would interpret the claims, may also be used.')(internal quotations and citations omitted).

We again note that Appellants addressed both interpretations in the First Request⁷ and even proposed “removing and/or modifying the ‘at least one of’ language” by amendment. (First Request, 9).⁸ Thus, on this record, our view is unchanged that both interpretations of the aforementioned language of claim 12 are plausible.

We note that “[i]ndefiniteness under 35 U.S.C. § 112 ¶ 2 is an issue of claim construction.” *Cordis Corp. v. Boston Scientific Corp.*, 561 F.3d 1319, 1331 (Fed. Cir. 2009)(citation omitted). As discussed above, the standard of claim construction applied by the USPTO differs from the *post-issuance* standard of claim construction applied by Federal Courts during patent infringement proceedings, such as *SuperGuide*.

The Federal Circuit Court has held in *post-issuance patent infringement* cases that the definiteness requirement “does not compel absolute clarity” and “only claims ‘not amenable to construction’ or ‘insolubly ambiguous’ are indefinite.” *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347 (Fed. Cir. 2005) (citations omitted).

In contrast to the Federal Circuit’s review of issued patent claims, *in proceedings before the USPTO*, “if a claim is amenable to two or more plausible claim constructions, the USPTO is justified in requiring the applicant to more precisely define the metes and bounds of the claimed invention by holding the claim . . . indefinite.” *Ex parte Miyazaki*, 89 USPQ2d 1207, 1211 (BPAI 2008) (precedential), *available at*

⁷ The First Request for Rehearing was received on Jan. 3, 2012.

⁸ We note that Appellants may only amend after the date of filing a notice of appeal pursuant to 37 C.F.R. §41.31(a), if the amendment meets the criteria of 37 C.F.R. §41.33.

<http://www.uspto.gov/ip/boards/bpai/decisions/prec/fd073300.pdf>.

Thus, a claim that is not indefinite under the Federal Circuit Court's "insolubly ambiguous" standard (as applied to issued patent claims), may be considered indefinite under the USPTO *Miyazaki* standard of review that employs a lower threshold of ambiguity for pending patent application claims.

We have reconsidered our Rehearing Decision of Jan. 13, 2012, in light of Appellants' arguments in the Second Request. We note that each of Appellants' aforementioned arguments turns upon the proper claim construction to be accorded to independent claim 12.

Based upon our reconsideration of the record, we again conclude that claim 12 is subject to two alternative plausible interpretations and is therefore indefinite under § 112, second paragraph. *Miyazaki*, 89 USPQ2d at 1211.

As stated in our Rehearing Decision (5), a prior art rejection cannot be sustained if the hypothetical person of ordinary skill in the art would have to make speculative assumptions concerning the meaning of the claim language. *See In re Steele*, 305 F.2d 859, 862-863 (CCPA 1962).

CONCLUSION

We have considered the arguments raised by Appellants in the Second Request, but find none of these arguments are persuasive that our original Rehearing Decision was in error. It is our view that Appellants have not identified any points that the Board has misapprehended or overlooked. We have reconsidered our Rehearing Decision but decline to grant the relief requested.

ORDER

We have granted Appellants' request to the extent that we have reconsidered our Rehearing Decision (mailed Jan. 13, 2012), but we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv). *See also* 37 C.F.R. § 41.52(b).

REHEARING DENIED

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